APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,217	10/28/2003	Ludomir A. Budzyn	B-1	4967

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ART UNIT	PAPER NUMBER
2167	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/695,217	BUDZYN, LUDOMIR A.
	Examiner	Art Unit	
	Luke S. Wassum	2167	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>16 July 2007</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-16</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-16</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>28 October 2003</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.   The Applicants' amendment, filed 16 July 2007, has been received, entered into

the record, and considered.

2.   As a result of the amendment, claims 1 and 13 have been amended. Claims 1-16

remain pending in the application.

The Invention

3.   The claimed invention is a method for investigating intellectual property related

to a reference piece of intellectual property. In one embodiment, the user inputs a

trademark, and the system generates a list of patents and patent applications which are

related in some way to said trademark.

Priority

4.   The Applicant's claim to domestic priority under 35 U.S.C. § 119(e) based upon

U.S. Provisional Patent Application 60/421,710, filed 28 October 2002, is acknowledged.

Drawings

5.   The application includes informal (hand drawn) drawings. While these

drawings are acceptable for examination purposes, the examiner encourages the

Applicant to submit formal drawings at the earliest opportunity. Early submission of

formal drawings will help expedite post-allowance processing and publication of the

issued patent.

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

7.   The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1.   Determining the scope and contents of the prior art.
2.   Ascertaining the differences between the prior art and the claims at issue.
3.   Resolving the level of ordinary skill in the pertinent art.

4.   Considering objective evidence present in the application indicating obviousness or nonobviousness.

8.   Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Lee** (U.S. Patent 6,694,331) in view of **Ooishi** (U.S. Patent Application Publication 2002/0147793).

9.   Regarding claim 1, **Lee** teaches a method for investigating intellectual property related to a user inputted reference piece of intellectual property as claimed, said method comprising:

a) providing a first database of discrete pieces of first intellectual property, said

pieces of first intellectual property each including an associated set of first

characteristics (see disclosure that the system supports the analysis of

different types of intellectual property information, such as patents,

trademarks, copyrights, trade secrets, etc., col. 1, lines 16-22; see also col. 10,

lines 34-40; see also col. 11, line 63 through col. 12, line 7);

b) providing a second database of discrete pieces of second intellectual property,

said second intellectual property being of a different type from said first

intellectual property (see disclosure that the system supports the analysis of

different types of intellectual property information, such as patents,

trademarks, copyrights, trade secrets, etc., col. 1, lines 16-22; see also col. 10,

lines 34-40; see also col. 11, line 63 through col. 12, line 7);

c) searching said first database to identify said pieces of first intellectual property

having predetermined characteristics in common with the reference piece

of intellectual property (see disclosure of the identification of a 'source

grouping' of intellectual property information, col. 8, lines 17-28; see also

designation of a 'source grouping', col. 10, lines 34-45);

d) developing without user input at least one query based on at least a portion of

said first characteristics of said identified pieces of first intellectual

property (see disclosure of the use of a source grouping to generate a list of

'different elements' found in the source grouping, col. 8, line 56 through col.

9, line 15; see also col. 10, line 61 through col. 11, line 39; see also col. 11,

line 63 through col. 64, line 29);

e) searching said second database to identify said pieces of second intellectual

property satisfying said at least one query (see disclosure that the created

'field of search' can be used as a search query to be executed by a local or

remote database, col. 12, lines 26-29; see also disclosure that the invention

can be used to variously search and/or analyze information related to any

form of intellectual property, including patents and trademarks, col. 12,

lines 30-42); and

f) transmitting information related to said identified pieces of second intellectual

property to the user (see disclosure that other modules may be included

that, among other things, output the results achieved through operation of

the search server, col. 2, lines 7-11).

Lee does not explicitly teach a method wherein the second search is performed

without input from the user.

Ooishi, however, teaches as prior art a method of searching a first database, and

then without input from the user, generating a second query from the first search

results and applying said second query to a second database (see paragraphs [0006] and

[0007]).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to automate the process of generating secondary searches of additional

databases, since this would automatically provide relevant search results from

additional databases to the user without forcing the user to first confirm the subsequent

search of the second database.

10.   Regarding claim 2, **Lee** additionally teaches a method for investigating

intellectual property wherein said pieces of first intellectual property are selected from

the group consisting of registered trademarks, unregistered trademarks and

applications to register trademarks (see disclosure that the invention can be used to

variously search and/or analyze information related to any form of intellectual

property, including patents and trademarks, col. 12, lines 30-42).

11.   Regarding claims 3 and 5, **Lee** additionally teaches a method for investigating

intellectual property wherein said pieces of second intellectual property are selected

from the group consisting of patents and patent applications (see disclosure that the

invention can be used to variously search and/or analyze information related to any

form of intellectual property, including patents and trademarks, col. 12, lines 30-42).

12.   Regarding claims 4 and 6, **Lee** additionally teaches a method for investigating

intellectual property wherein the reference piece of intellectual property is a trademark

(see disclosure of the receipt of input data or signals from the user identifying select

intellectual property to form a 'source grouping' of intellectual property information,

col. 8, lines 17-28; see also the fact that the intellectual property information can include

trademarks, col. 8, lines 11-17).

13.   Regarding claim 7, **Lee** additionally teaches a method for investigating

intellectual property wherein said step of searching said first database includes

searching said first database to identify said pieces of first intellectual property which

are identical matches to the reference piece of intellectual property (see disclosure that

the select intellectual property information input by the user may be individual

intellectual property identified by native indicia, which would include identifying

trademarks which identically matched an input native indicia, col. 8, lines 30-34).

14.   Regarding claim 8, **Lee** additionally teaches a method for investigating

intellectual property wherein said step of searching said first database includes

searching said first database to identify said pieces of first intellectual property which

include at least one search term in common with at least a portion of the reference piece

of intellectual property (see disclosure that the select intellectual property information

input by the user may be individual intellectual property identified by native indicia,

which would include identifying trademarks which have, for instance, a common

assignee, col. 8, lines 30-34).

15.   Regarding claim 9, **Lee** additionally teaches a method for investigating

intellectual property further comprising sorting said identified pieces of first intellectual

property (see disclosure of the sorting of search results, col. 4, lines 49-57 et seq.).

16.   Regarding claim 10, **Lee** additionally teaches a method for investigating

intellectual property wherein said step of sorting includes comparing each of said

identified pieces of first intellectual property with the reference piece of intellectual

property to determine degree of similarity therebetween (see disclosure of the sorting of

search results based upon relevancy or weighted relevancy, col. 4, lines 49-57 et seq.).

17.   Regarding claim 11, **Lee** additionally teaches a method for investigating

intellectual property wherein said steps of developing at least one query and searching

said second database are sequentially conducted for each identified piece of first

intellectual property (see disclosure that each piece of intellectual property in the source

grouping is reviewed in order to ascertain different elements to be used as search

criteria, col. 8, lines 56-63; see also col. 10, line 61 through col. 11, line 2; see also col. 11,

line 63 through col. 12, line 7; also note that for at least the cases where none or exactly

one piece of first intellectual property is identified, the execution of said developing

step and searching step is de facto sequential).

18.   Regarding claim 12, **Lee** additionally teaches a method for investigating

intellectual property wherein one of said first characteristics includes the name of the

owner of the associated said piece of first intellectual property, and wherein said at least

one query includes a first query, said first query being to identify all pieces of second

intellectual property in which the owner of the respective said identified piece of first

intellectual property has rights (see disclosure that the search engine performs searches

based on input data such as Inventor and Assignee, col. 4, lines 15-29).

19.   Regarding claim 13, **Lee** additionally teaches a method for investigating

intellectual property wherein said first query being to identify all pieces of second

intellectual property in which the owner of the respective said identified piece of

intellectual property has recorder ownership rights (see disclosure that the search

engine performs searches based on input data such as Inventor and Assignee, col. 4,

lines 15-29).

20.   Regarding claim 14, **Lee** additionally teaches a method for investigating

intellectual property wherein one of said first characteristics includes the goods or

services of the associated said piece of first intellectual property, and wherein said at

least one query includes a second query, said second query being to identify all said

pieces of second intellectual property which relate to the goods or services of the

respective said identified piece of first intellectual property (see disclosure that the

intellectual property can be searched based on classification, including the classification

of goods and services for trademarks, col. 6, lines 35-56).

21.   Regarding claim 15, **Lee** additionally teaches a method for investigating

intellectual property wherein one of said first characteristics includes information

relating to dates of first use of the associated said piece of first intellectual property, and

wherein said at least one query includes a third query, said third query being to identify

all said pieces of second intellectual property having a filing date or priority date after

the dates of first use of the respective said identified piece of first intellectual property

(see disclosure that the search engine performs searches based on input data such as

Publication Date, Filing Date, Related Data and Priority Data, col. 4, lines 15-29).

22.   Regarding claim 16, **Lee** additionally teaches a method for investigating

intellectual property wherein one of said first characteristics includes a classification of

the associated said piece of first intellectual property, and wherein said at least one

query includes a fourth query, said fourth query being to identify all said pieces of

second intellectual property having a classification equivalent to the classification of the

respective said identified piece of first intellectual property (see disclosure that the

search engine performs searches based on input data such as International

Classification, U.S. Classification, and Cross-Reference Classification, col. 4, lines 15-29).

Response to Arguments

23.   The Applicant's arguments regarding the applicability of the **Frank et al.**

reference have been considered, and in view of the amendment to claim 1, are

persuasive.

24.   Furthermore, the Applicant's arguments regarding the rejections of record based

upon the **Lee** reference have been considered, and not been found persuasive.

However, in order to more rapidly advance prosecution of the application, a new

reference has been incorporated into the rejections in order to teach the automatic

search of a second database based upon the search results from a first database.

Conclusion

25.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

Jensen-Grey (U.S. Patent Application Publication 2002/0099697) teaches a system

for searching wherein an initial search string is provided to a search system, the search

results are parsed in order to identify metadata related to the search results, and the

metadata is used as a new search term to the search system.

Minch et al. (U.S. Patent Application Publication 2004/0049510) teaches a method

of searching a plurality of databases, wherein a search of the first database is

performed, and links from the search results to records in the second database are

executed.

Hamilton et al. (U.S. Patent Application Publication 2004/0122807) teaches a

system for retrieving information, wherein a first database is searched, and the search

result is used to automatically generate and execute a query in a second database.

Jensen-Grey (U.S. Patent 6,941,300) teaches a system for searching wherein an initial search string is provided to a search system, the search results are parsed in order to identify metadata related to the search results, and the metadata is used as a new search term to the search system.
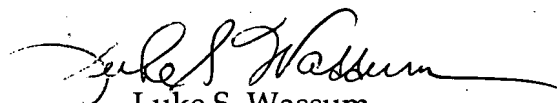
Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Luke S. Wassum whose telephone number is 571-272-

4119. The examiner can normally be reached on Monday-Friday 8:30-5:30, alternate

Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John R. Cottingham can be reached on 571-272-7079. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

In addition, INFORMAL or DRAFT communications may be faxed directly to the

examiner at 571-273-4119. Such communications must be clearly marked as

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Customer Service for Tech Center 2100 can be reached during regular business

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USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Primary Examiner
Art Unit 2167

lsw
17 September 2007